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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206284
Party	Defendant Haze Tobacco, LLC
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Signature	/Marcus Peterson/
Date	07/08/2016
Attachments	Answer to Starbuzz Notice of Opposition re HAZE TOBACCO.pdf(1176721 bytes)

Registration Subject to the filing

Registration No	3736577	Registration date	01/12/2010
Registrant	Starbuzz Tobacco, Inc. 10871 Forbes Ave Garden Grove, CA 92843 UNITED STATES		

Goods/Services Subject to the filing

Class 034. First Use: 2008/01/09 First Use In Commerce: 2008/01/09
All goods and services in the class are requested, namely: PIPE TOBACCO, TOBACCO, SMOKING TOBACCO, FLAVORED TOBACCO, MOLASSES TOBACCO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of:	§	Opposition No. 91206284
Haze Tobacco, LLC	§	
Serial No.: 85/303,577	§	International Class: 034
	§	
Filed: April 25, 2011	§	Published: April 3, 2012
	§	
Mark: HAZE TOBACCO	§	

APPLICANT HAZE TOBACCO, LLC'S ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIMS

Applicant Haze Tobacco, LLC ("Applicant" or "Haze") by and through its attorney of record, hereby Answers Opposer Starbuzz Tobacco, Inc.'s ("Opposer" or "Starbuzz") Notice of Opposition and states as follows:

- 1) Admit.
- 2) Admit as to the content shown in U.S. Reg. No. 3736577. Applicant is without sufficient information to admit or deny the remainder of the allegations in Paragraph 2 and on that basis denies the allegations.
- 3) Admit as to the content shown in U.S. Ser. No. 85/515,157. Applicant is without sufficient information to admit or deny the remainder of the allegations in Paragraph 3 and on that basis denies the allegations.
- 4) Paragraph 4 does not contain an allegation, and therefore does not require a response. To the extent it does, Applicant denies that "Starbuzz marks" is an accurate term to describe Starbuzz's rights in "Blueberry Haze," and "Haze."
- 5) Admit.
- 6) Admit.
- 7) Admit.
- 8) Admit.
- 9) Admit that the USPTO issued a preliminary office action, the content of which is self-evident, and that the USPTO approved and published Applicant's HAZE TOBACCO mark. Admit that the date of publication was April 3, 2012.

10) The allegation in Paragraph 10 is not relevant to the merits of the Notice of Opposition. Nonetheless, Applicant admits this allegation.

11) Applicant is without sufficient information to admit or deny the allegations in Paragraph 11 and on that basis denies the allegations.

12) Applicant is without sufficient information to admit or deny the allegations in Paragraph 12 and on that basis denies the allegations.

13) Admit that Mr. Nouredine has performed work for Applicant.

14) Applicant is without sufficient information to admit or deny the allegations in Paragraph 14 and on that basis denies the allegations.

15) Deny.

16) Admit that Applicant applied to register the marks HAZE HOOKAH LOUNGE, HAZE COLADA, and PASSION. Deny the remainder of the allegations and the implication that the marks applied for by Applicant are confusingly similar to the marks cited by Opposer, as evidenced by the USPTO's examination and approval of those marks.

17) Deny.

18) Deny that Opposer was using the trademark HAZE prior to April 25, 2011.

19) Applicant is without sufficient information to admit or deny the allegations in Paragraph 19 and on that basis denies the allegations.

20) Applicant is without sufficient information to admit or deny the allegations in Paragraph 20 and on that basis denies the allegations.

21) To the extent a response is necessary, Applicant re-alleges and incorporates the responses to Paragraphs 1-20 as set forth above.

22) Applicant admits that Opposer's application for the HAZE mark was suspended by the USPTO. Opposer applied to register the mark HAZE knowing that Applicant had already applied to register the mark HAZE TOBACCO.

23) Deny.

24) Deny.

25) To the extent a response is necessary, Applicant re-alleges and incorporates the responses to Paragraphs 1-24 as set forth above.

26) Applicant admits the content of the Application and supporting Declaration.

27) Deny.

28) Deny.

29) Deny.

30) Applicant admits that the mark HAZE TOBACCO registered. In Applicant's February 6, 2012 response to an office action relating to its application for HAZE TOBACCO, Applicant noted the differences in appearance and commercial impression of Applicant's HAZE TOBACCO mark and Opposer's BLUEBERRY HAZE mark. The USPTO agreed, as Applicant's registration was published for opposition on April 3, 2012.

31) Deny.

32) Deny.

33) Deny.

34) Deny.

35) Deny.

36) Deny.

37) To the extent a response is necessary, Applicant re-alleges and incorporates the responses to Paragraphs 1-36 as set forth above.

38) The allegations in Paragraph 38 call for a legal conclusion as to the distinctiveness of the mark “HAZE.” Applicant is unable to provide a response to the legal argument, and to the extent the allegations require a response, Applicant denies the allegations in Paragraph 38.

39) Applicant denies that Opposer has superior rights in the term “HAZE” and also denies that Applicant’s application would create a likelihood of confusion with Opposer’s trademarks.

40) Applicant admits that Opposer’s HAZE application intentionally copies Applicant’s HAZE TOBACCO mark. Applicant denies the remaining implications and allegations in Paragraph 40.

41) Applicant admits that Opposer’s HAZE mark is allegedly used on tobacco products. Applicant denies that Opposer’s BLUEBERRY HAZE mark is used on tobacco products.

42) As the term “Opposer’s goods” is undefined, Applicant is without sufficient information to admit or deny the allegations in Paragraph 42 and on that basis denies the allegations.

43) As the term “Opposer’s goods” is undefined, Applicant is without sufficient information to admit or deny the allegations in Paragraph 43 and on that basis denies the allegations.

44) As the term “Opposer’s goods” is undefined, Applicant is without sufficient information to admit or deny the allegations in Paragraph 44 and on that basis denies the allegations.

45) Admit that Opposer’s BLUEBERRY HAZE mark registered on January 12, 2010. Applicant denies the remainder of the allegations in Paragraph 45.

46) Applicant admits that Opposer has no control over the nature and quality of Applicant’s goods. Applicant denies the remainder of the allegations in Paragraph 46.

47) Deny.

48) Deny.

49) Applicant denies that its conduct creates a likelihood of confusion with Opposer’s trademark rights.

AFFIRMATIVE DEFENSES

First Affirmative Defense

(Unclean Hands)

Opposer purposefully commenced use of the HAZE mark on tobacco products well after the success of Applicant’s HAZE TOBACCO. Opposer’s *post hoc* adoption of Applicant’s mark, and its efforts to engage in a scheme to suppress competition in the industry by opposing Applicant’s registration of its mark, and attempting to prevent Applicant from selling its competing product, constitutes unclean hands.

Additionally, Opposer’s conduct in this matter is consistent with its treatment of other competitors in this industry. See, as one example, *Starbuzz Tobacco, Inc. v. Fantasia Dist., Inc.*, Case No. SACV12-1328 JVS (JPRx), filed August 17, 2012 in the Central District of California.

Opposer should not be allowed to assert rights that have been obtained, if at all, through such methods.

Second Affirmative Defense

(Fraud on the USPTO)

Opposer applied to register the mark HAZE on January 12, 2012, in connection with “Pipe Tobacco, Molasses Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco,” claiming first use as of January 13, 2011. According to the results of an investigation conducted by Applicant, Opposer had not used the mark HAZE in connection with any of the goods listed in its application as of that date. As such, this statement was a material misrepresentation to the USPTO. To date, Starbuzz has never offered for sale any products bearing the HAZE mark.

In connection with its application, Starbuzz filed a specimen of use, showing a label for a product that appeared to be HAZE-branded tobacco (see below). Applicant’s investigation shows that Opposer had not sold any products bearing the label shown in Opposer’s specimen of use at the time of filing the application or by the time the registration issues. In fact, to date, Starbuzz has never sold products bearing the label shown in the specimen of use. As such, attaching the false specimen of use was also a material misrepresentation to the USPTO.



Starbuzz made these material misrepresentations with the intent to deceive the USPTO into granting it a registration for the term HAZE to which it was not entitled. Opposer did this

because it knew Applicant had applied for the mark HAZE TOBACCO nearly a year earlier and Opposer sought to prevent Applicant from using its own mark.

Because of these material misrepresentations, Opposer's HAZE application should not be used as a basis for finding that Opposer has superior rights to the term HAZE as compared to Applicant. Applicant applied for HAZE TOBACCO and used HAZE TOBACCO in commerce prior in time to Opposer, and as such, has senior rights in the mark HAZE TOBACCO.

FIRST COUNTERCLAIM

Cancellation or Amendment of U.S. Reg. No. 3,736,577

1. Opposer applied to register the mark BLUEBERRY HAZE on June 8, 2009, in connection with "Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco," claiming first use in commerce as of January 1, 2008.

2. According to the results of an investigation conducted by Applicant, Starbuzz was not using the BLUEBERRY HAZE mark in connection with all of the goods and services listed in its application as of the claimed date of first use (January 9, 2008) or as of the date of Starbuzz's application to register the mark (June 8, 2009). As such, Starbuzz's claimed first use date, and the scope of claimed use, were material misrepresentations.

3. Starbuzz filed a specimen of use with the USPTO to support its use-based application. That specimen shows that a company called Hypnosis used the term "Blueberry Haze" as the name of a flavor of one of its tobacco products. Compare specimen filed in connection with BLUEBERRY HAZE application (left) to Starbuzz product packaging (right).



4. Upon information and belief, even to this day, Starbuzz has not used the mark BLUEBERRY HAZE in commerce.

5. Starbuzz made these material misrepresentations to the USPTO with the intent to deceive the USPTO into granting registration to the BLUEBERRY HAZE mark. The USPTO relied on these material misrepresentations in granting registration for BLUEBERRY HAZE on January 12, 2010.

6. Because Starbuzz made material misrepresentations to the USPTO with the intent to deceive the USPTO, and because the USPTO relied on those misrepresentations, Reg. No. 3,765,577 should be cancelled as having been obtained through fraud.

7. Even if Starbuzz is able to demonstrate use of BLUEBERRY HAZE in commerce prior to June 8, 2009, Starbuzz never used the mark as more than a flavor of tobacco. As such, if the Board determines the registration should not be cancelled, it should be amended to denote that “Blueberry Haze” is a flavor of tobacco and not the source of the tobacco bearing that mark.

Respectfully submitted,

HAZE TOBACCO, LLC.

Date: July 8, 2016

By: /s/ Marcus Peterson
Marcus Peterson
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Attorneys for Opposer

CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT: July 8, 2016

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

/s/ Marcus Peterson

Marcus Peterson

CERTIFICATE OF SERVICE VIA FIRST CLASS MAIL

I, Marcus Peterson, Esq., of Pillsbury Winthrop Shaw Pittman LLP, attorneys for Applicant Haze Tobacco, LLC, hereby certify that a true and complete copy of the foregoing APPLICANT HAZE TOBACCO, LLC'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS was served on Counsel for Starbuzz Tobacco, Inc. on Natu Patel, The Patel Law Firm, P.C., 2532 Dupont Drive, Irvine, CA 92612.

/s/ Marcus Peterson

Marcus Peterson